

REMARKS

Claims 39-41, 45-47 and 51-52 are now pending in the application. The Examiner is respectfully requested to reconsider and withdraw the rejection(s) in view of the amendments and remarks contained herein.

REJECTION UNDER 35 U.S.C. § 112

Claims 39 and 40 stand rejected under 35 U.S.C. § 112, first paragraph, as failing to comply with the written description requirement. This rejection is respectfully traversed.

With regard to the claimed phrase "at the same selected operating point" that the Examiner considers as new matter, the Applicants note that the Application discloses a "desired field F at the operating point," and "As shown in FIG. 17, an appropriate uniform magnetization direction for the magnet segment is determined." (see ¶ [0079] of the present application). The Application further states that "The direction of magnetization in each of these segments 500a,a though 500j,k is the direction of magnetization at the location of the center of mass of the segment...and the magnetization direction is determined for the location of the center of mass that will provide the maximum contribution to the desired field F." (see ¶ [0081] of application). Thus, the "magnet 500 is specially constructed to provide a magnetic field F in a selected direction at a selected operating point 506 spaced from the front face 502 of the magnet." (see ¶ [0074] of the present application). While the Applicants do not agree that "at the same selected operating point" constitutes new matter or is not supported by the specification, the Applicants have amended claims 39 and 40 to recite "at a selected operating point" consistent with the language in the specification. Thus, the Applicants submit that claims 39 and 40 particularly point out the claimed subject matter, and that the above rejection has been traversed.

REJECTION UNDER 35 U.S.C. § 102

Claims 39-41, 45-47 and 51-52 stand rejected under 35 U.S.C. § 102(b) as being anticipated by *Kioke* (U.S. Pat. No. 3,971,963). This rejection is respectfully traversed.

Independent Claims 39, 41 and 45

According to the Office Action, *Kioke* discloses “providing a plurality of segments (e.g. 62, 62', 66, 66')...to be arranged in a parallel manner to form a magnet assembly.” However, *Kioke* does not disclose segments arranged in a parallel manner, but rather describes magnets 62 and 62' as being “isolated from each other” so as to be “split” permanent magnets 62 and 62'. *Kioke* also states that magnets 66, 66' are “also isolated from each other.”

The Examiner also contends *Kioke* discloses forming a magnet assembly that contributes to a magnetic field at an operating point spaced from the magnet assembly. However, *Kioke* discloses (4) separate magnet segments, magnets 62, 62' that establish a magnetic field in diametrically opposed air gaps 64, 64' and magnets 66, 66' that establish a magnetic field in diametrically opposed air gaps 68, 68'.

Kioke's (4) separated magnets (62, 62', 66, 66') that establish magnetic fields in different gap locations can no more define the claimed compound magnet assembly than *Holcomb's* (4) separate cylindrical magnets could define a compound magnet assembly. The Applicants note that the Board of Patent Appeals and Interferences agreed with the Applicants, that the (4) separate cylindrical magnets in *Holcomb* do not disclose the claimed compound magnet assembly providing a magnetic field in a selected direction at a point spaced from the compound magnet assembly. The Applicants submit that *Kioke's* separate magnets also fail to disclose the claimed compound magnet assembly.

The Applicants recognize that during prosecution before the Office, the claims are to be given their broadest reasonable interpretation consistent with the specification as it would be interpreted by one of ordinary skill in the art. *In re American Academy of Science Tech. Center*, 367 F.3d 1359, 1364 (Fed. Cir. 2004). However, the Federal Circuit has maintained that a term in a cited reference cannot reasonably be construed to describe a claimed limitation in a manner that is inconsistent with that disclosed in the specification. (See *In re Buszard*, 504 F.3d 1364, 84 U.S.P.Q.2d 1749 (2007); where the Court held that no matter how broadly a “flexible foam reaction mixture” in the cited reference is construed, the cited reference cannot reasonably be construed to describe a flexible foam product, and that it is not a reasonable claim interpretation to equate “flexible” with a “rigid” material in a cited reference).

However, a person of ordinary skill in the art would not interpret the claimed compound magnet assembly, comprising a plurality of segments each magnetized to provide a magnetic field in a selected direction at a selected operating point spaced from the front face of the compound magnet assembly, to read on or encompass *Kioke's* (4) separated magnets 62, 62', 66, 66' that each establish magnetic fields in different air gap locations. *Kioke's* (4) separate magnets cannot be reasonably interpreted to disclose Applicants' compound magnet assembly, comprising a plurality of segments each magnetized to provide a magnetic field in a selected direction at a selected operating point spaced from the front face of the compound magnet assembly.

Moreover, *Kioke's* (4) separated magnets 62, 62', 66, 66' establish magnetic fields in air gap locations between magnets 62, 62' and between magnets 66, 66', which is not the same as the claimed compound magnet that provides a magnetic field at a selected operating point spaced from the front face of the compound magnet assembly.

Kioke's (4) separated magnets (62, 62', 66, 66') that establish magnetic fields in airgaps inside of *Kioke's* assembly can no more provide a magnetic field at a selected operating point spaced from the front face of the claimed compound magnet assembly than *Leupold's* magnet could define a magnetic field spaced from a front face of a magnet. The Applicants note that the Board of Patent Appeals and Interferences agreed with the Applicants, that *Leupold's* magnet 40 generated a field H within an internal cavity (17, 44) of the magnet that too constraining to be useful as an operating point, rather than a magnetic field that is spaced from a front face of a compound magnet assembly.

Thus, the Applicants submit that *Kioke's* separate magnets for generating a magnetic field in airgaps within *Kioke's* assembly also fail to disclose the claimed compound magnet assembly providing a magnetic field in a selected direction at a point spaced from the compound magnet assembly. As such, the Applicants submit that *Kioke* does not disclose each and every element of claims 39, 41 and 45, and that these claims are allowable for at least these reasons.

With regard to claims 39-40, 46-47 and 51-52, these claims ultimately depend from claims 39, 41 and 45, which the Applicants believe to be allowable for at least these reasons. As such, the Applicants believe that claims 39-40, 46-47 and 51-52 are also allowable for at least these reasons.


With regard to the claimed phrase "compound magnet assembly," the Applicants note that ¶ [0081] of the present application clearly discloses "manufacture of the segments and their assembly into a compound magnet." Thus, the Applicants submit that this claim feature is fully supported by the specification.

CONCLUSION

It is believed that all of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider and withdraw all presently outstanding rejections. It is believed that a full and complete response has been made to the outstanding Office Action and the present application is in condition for allowance. Thus, prompt and favorable consideration of this amendment is respectfully requested. If the Examiner believes that personal communication will expedite prosecution of this application, the Examiner is invited to telephone the undersigned at (314) 446-7638.

Respectfully submitted,

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